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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,051	03/22/2006	David A Daniel	03-1062-A	8394
20306 7590 07/19/2010 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER				
TORIMERO, ADETOKUNBO OLUSEGUN				
ART UNIT		PAPER NUMBER		
3714				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,051

Applicant(s)

DANIEL ET AL.

Examiner

ADETOKUNBO O. TORIMIRO

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date 06/02/2005, 05/22/2007
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The Preliminary amendment received on 06/02/2005 has been considered. It has been noted that claims 3,9,19, and 24 have been amended.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because it is not presented clearly on a separate sheet. Correction is required. See MPEP § 608.01(b). The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Claim Objections

4. Claims 2-14 and 16-30 are objected to because of the following informalities:

Claims 2-14, line 1:"a system" should be -- the system --.

Claims 16-30, line 1:"a method" should be -- the method --.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 16-30 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by recording an amount wagered on each turn of the game and deriving a primary statistic for each pair of participating players.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus. Thus, claims 16-30 are non-statutory since they may be preformed within the human mind.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-6 and 16-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,2,4-6,10,11, and 13-15 of U.S. Patent No. 7,699,702. Although the conflicting claims are not identical, they are not patentably distinct from each other because although ‘702 teaches tertiary statistics and the present application teach

primary statistics, they are both still similar functions of total number of turns of the game played, which examiner believes as written is almost interchangeable. Further patent '702 mentions pair or players while the present application teaches two or more, which examiner believes to be obvious.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3,7-18, and 22-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Sidley (US 4,926,327).

Re claims 1,2,7-9,16,17, and 22-24: Sidley discloses a system for detecting and controlling collusion in a multiplayer game having a plurality of participating players in which the players compete against each other to determine a winner (**see abstract**), the system comprising: recording means for recording, for the players, an amount wagered on each turn of the game in which the player participates, and a corresponding outcome of said wager (**see col.42, lines 65-col.43, lines 11**); a ranking facility operable to derive a primary statistic for each player, the primary statistic being a function of a total number of turns of the game played by the player / *wherein using a matrix each player is compared and ranked against every other player per every turn the player plays against the other players such first player against second player, first player against third, etc* (**see col.43, lines 19-43**), and the outcomes of the wagers made by the player in these turns of the game; and monitoring means for monitoring the primary statistic

of each player and generating an output when the primary statistic of any player changes by more than a predetermined amount, the output being an indicator of possible collusion by that player / *wherein the matrix software functions as the monitoring means for monitoring, calculating, and determining the outcomes and output of the game for the players (see col.43, lines 32-43);* the outcome being a complete or partial forfeit of the wager if the wager is unsuccessful, and a profit made on the wager if the wager is successful / *it is an inherent feature of wagering games that the payout is either a complete loss or partial loss if there is no success and a profit made in addition to the wagered amount if there success for the player.*

Re claim 3 and 18: Sidley discloses a system which includes storage means capable of storing the primary statistic for each player in respect of each one of a number of different levels of play of the game, a level of play being determined by wagering limits applicable to the game / *wherein upon completion of the polling of each player, the status and stake or wager data are received from the player's console and stored (see col.15, lines 63-66 and claim 1).*

Re claims 10-15 and 25-30: Sidley discloses a system in which the game is a variation of the game of poker such as , Texas Hold' Em, Seven Card Stud, Five Card Stud, and/or Five Card draw, etc (see abstract; figs.27-29; col.2, lines 44-51; col.46 lines 33-39); wherein according to lines 44-51 of col.2, any type of the game variation with various payouts, outcomes, and ratio can be programmed.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 4-6 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sidley (US 4,926,327) in view of Alcorn et al (US 6,104,815).

Re claims 4-6 and 19-21: The teachings of Sidley have been discussed above.

However, Sidley does not explicitly teach control facility operable to suspend a player for whom monitoring means has generated an output; geo-location means for determining the geographical location of any player; wherein the control facility suspends any two or more players for whom the monitoring facility has generated an outcome.

Alcorn et al teaches a method and apparatus using geographical position determination means to provide authentication and security between remote gaming locations wherein the player's gaming terminals location is informed to the host server, wherein based on this location information provided to the game host server / *control facility*, the host server can permit or deny game play based on geographical restrictions, which could include not more than player allowed a particular location at a given time (**see claim 1**).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Alcorn et al into the teaching of Sidley. One would be motivated to do this so as to have a game system where authentication and game security is provided to the game thereby reducing cheaters and fraudulent players from participating in the game play.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adetokunbo O. Torimiro whose telephone number is (571) 270-1345. The examiner can normally be reached on Mon-Fri (8am - 4pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on (571) 272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/A. O. T./

Examiner, Art Unit 3714

/John M Hotaling II/

Primary Examiner, Art Unit 3714